

REMARKS

Forty-three claims were originally filed in the present Application. Claims 1-43 currently stand rejected. Claims 1-2, 8, 18, 21-22, 28 and 38 are amended herein. Reconsideration of the Application in view of the foregoing amendments and the following remarks is respectfully requested.

35 U.S.C. § 102(e)

In paragraph 2 of the Office Action, the Examiner rejects claims 1, 5, 9, 21, 25, 29, 42, and 43 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2001/0010059 to Burman et al. (hereafter Burman). The Applicants respectfully traverse these rejections for at least the following reasons.

“For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be *identically* shown in a single reference.” *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (CAFC 1988). The Applicants submit that Burman fails to identically teach every element of the claims, and therefore does not anticipate the present invention.

Regarding the Examiner’s rejection of independent claims 1 and 21, Applicants respond to the Examiner’s §102 rejection as if applied to amended independent claims 1 and 21 which are now amended to recite “*said source device being implemented to include a digital camera device*” which are limitations that are not taught or suggested either by the cited reference, or by the Examiner’s citations thereto.

In addition, in the rejections of claims 1, 5, 21, 25, 42, and 43, the Examiner cites “page 5, paragraph [0035]” of Burman for support of the foregoing rejections. However, after review of the cited reference, Applicants find no such paragraph on page five of Burman. Applicants therefore request the Examiner to clarify the grounds for rejections of claims 1, 5, 9, 21, 25, 29, 42, and 43 by explicitly indicating where the foregoing citation to Burman may be found.

Burman teaches a “server” of a computer network that transfers information to a network device (see Abstract). The data flow of Burman is therefore from server to device. In contrast, Applicants claim a “digital camera device” that transfers information to a “destination device” that may be implemented as “an image station website”. Applicants submit that their claimed “digital camera device” is not analogous to the “server” taught by Burman. Applicants also maintain that Burman teaches a data flow that is directly opposite from the data flow from camera to website as disclosed and claimed by Applicants. Applicants therefore submit that Burman teaches away from their claimed invention.

With regard to claim 43, “means-plus-function” language is utilized to recite elements and functionality similar to those recited in claims 1 and 21 which are discussed above. Applicants therefore incorporate those remarks by reference with regard to claim 43. In addition, the Courts have frequently held that “means-plus-function” language, such as that of claim 43, should be construed in light of the Specification. More specifically, means-plus-function claim elements should be *construed to cover the corresponding structure, material*

or acts described in the specification, and equivalents thereof. Applicants respectfully submit that, in light of the substantial differences between the teachings of Burman and Applicants' invention as disclosed in the Specification, claim 43 is therefore not anticipated or made obvious by the teachings of Burman.

Regarding the Examiner's rejection of dependent claims 5, 9, 25, and 29, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 5, 9, 25, and 29 so that these claims may issue in a timely manner.

Because a rejection under 35 U.S.C. §102 requires that each and every claimed limitation be *identically* taught by a cited reference, and because the Examiner fails to cite Burman to identically teach or suggest the claimed invention Applicants respectfully request reconsideration and allowance of claims 1, 5, 9, 21, 25, 29, 42, and 43 so that these claims may issue in a timely manner.

35 U.S.C. § 103

In paragraph 4 of the Office Action, the Examiner rejects claims 2-4, 6-8, 22-24, and 26-28 under 35 U.S.C. § 103 as being unpatentable over Burman in

view of U.S. Patent No. 6,166,729 to Acosta et al. (hereafter Acosta). The Applicants respectfully traverse these rejections for at least the following reasons.

Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a) which requires that three basic criteria must be met, as set forth in M.P.E.P. §2142:

"First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The initial burden is therefore on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 2-4, 6-8, 22-24, and 26-28, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 2-4, 6-8, 22-24, and 26-28 so that these claims may issue in a timely manner.

Furthermore, the Examiner concedes that "Burman fails to teach wherein said source device is implemented to include a digital camera device." Applicants

concur. The Examiner then points to Acosta to purportedly remedy these defects. Acosta is limited to teaching a “camera device” that sends image data to a “server” on the Internet (see Abstract). Applicants submit that since Burman teaches away from Applicants’ invention (as discussed above in conjunction with the rejections of claims 1 and 21), the combination of Acosta and Burman would not result in Applicants’ invention.

In addition, claims 8 and 28 are amended herein to recite “*said one or more transfer option fields include a perform transfer option, a cancel transfer option, a postpone transfer option, a change transfer-mode option, and an alter transfer-data option, said alter transfer-data option including a reduce data-size option, an increase data-size option, a crop image option, a reduce image-resolution option, an increase image-resolution option, and a compress data option.*” Applicants submit that the cited references fail to disclose the utilization of transfer option fields that are implemented in any manner that is similar to those techniques disclosed and claimed by Applicants.

For at least the foregoing reasons, the Applicants submit that claims 2-4, 6-8, 22-24, and 26-28 are not unpatentable under 35 U.S.C. § 103 over Burman in view of Acosta, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 2-4, 6-8, 22-24, and 26-28 under 35 U.S.C. § 103.

In paragraph 5 of the Office Action, the Examiner rejects claims 10-11 and 30-31 under 35 U.S.C. § 103 as being unpatentable over Burman in view of U.S.

Patent No. 5,774,583 to Sasaki et al. (hereafter Sasaki). The Applicants respectfully traverse these rejections for at least the following reasons.

Regarding the Examiner's rejection of dependent claims 10-11 and 30-31, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 10-11 and 30-31 so that these claims may issue in a timely manner.

Furthermore, the Court of Appeals for the Federal Circuit has held that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). As discussed above, Burman teaches away from Applicants' claimed invention. Applicants therefore submit that the cited references do not suggest a combination that would result in Applicants' invention, and therefore the obviousness rejections under 35 U.S.C §103 are improper.

For at least the foregoing reasons, the Applicants submit that claims 10-11 and 30-31 are not unpatentable under 35 U.S.C. § 103 over Burman in view of Sasaki, and that the rejections under 35 U.S.C. § 103 are thus improper. The

Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 10-11 and 30-31 under 35 U.S.C. § 103.

In paragraph 6 of the Office Action, the Examiner rejects claims 12-17 and 32-37 under 35 U.S.C. § 103 as being unpatentable over Burman in view Sasaki, and further in view of JP Patent Application No. 09-060776 to Norio et al. (hereafter Norio). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants respectfully traverse the Examiner's assertion that modification of the device of Burman according to the teachings of Sasaki and Norio would produce the claimed invention. Applicants submit that Burman in combination with Sasaki and Norio fail to teach a substantial number of the claimed elements of the present invention. Furthermore, Applicants also submit that neither Burman, Sasaki, nor Norio contain teachings for combining the cited references to produce the Applicants' claimed invention. The Applicants therefore respectfully submit that the obviousness rejections under 35 U.S.C §103 are improper.

Further regarding the Examiner's rejection of dependent claims 12-17 and 32-37, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 12-17 and 32-37 so that these claims may issue in a timely manner.

For at least the foregoing reasons, the Applicants submit that claims 12-17 and 32-37 are not unpatentable under 35 U.S.C. § 103 over Burman in view of Sasaki and Norio, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 12-17 and 32-37 under 35 U.S.C. § 103.

In paragraph 7 of the Office Action, the Examiner rejects claims 18-19 and 38-39 under 35 U.S.C. § 103 as being unpatentable over Burman in view of Sasaki, Norio, and Acosta. The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie*

case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner's rejection of dependent claims 18-19 and 38-39, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 18-19 and 38-39 so that these claims may issue in a timely manner.

In addition, claims 18 and 48 are amended herein to recite "*said transfer options include a perform transfer option, a cancel transfer option, a postpone transfer option, a change transfer-mode option, and an alter transfer-data option, said alter transfer-data option including a reduce data-size option, an increase data-size option, a crop image option, a reduce image-resolution option, an increase image-resolution option, and a compress data option.*" Applicants submit that the cited references fail to disclose the utilization of transfer option fields that are implemented in a manner that is similar to that disclosed and claimed by Applicants.

For at least the foregoing reasons, the Applicants submit that claims 18-19 and 38-39 are not unpatentable under 35 U.S.C. § 103 over Burman in view of Sasaki, Norio, and Acosta, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 18-19 and 38-39 under 35 U.S.C. § 103.

In paragraph 8 of the Office Action, the Examiner rejects claims 20 and 40 under 35 U.S.C. § 103 as being unpatentable over Burman in view of U.S. Patent No. 6,078,919 to Ginzburg et al. (hereafter Ginzburg). The Applicant respectfully traverses these rejections for at least the following reasons.

Regarding the Examiner's rejection of dependent claims 20 and 40, for at least the reasons that these claims are directly or indirectly dependent from respective independent claims whose limitations are not identically taught or suggested, the limitations of these dependent claims, when viewed through or in combination with the limitations of the respective independent claims, are also not identically taught or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claims 20 and 40 so that these claims may issue in a timely manner.

Also with regard to claims 20 and 40, the Examiner states that “[i]t would have been obvious to one in the ordinary skill in the art . . . to incorporate wherein said system user specifies an optimal value for said transfer duration. . . to deliver data over a wide variety of different types of network”

Applicants respectfully submit that a *general restatement of the advantages disclosed by the Applicants* deriving from implementation of the present invention cannot act as the required teaching or suggestion to combine cited references for a proper rejection under 35 U.S.C. § 103. Courts have repeatedly held that “it is impermissible . . . simply to engage in *hindsight reconstruction* of the claimed invention, using the Applicants’ structure as a template and selecting elements

from references to fill in the gaps.” In re Gorman, 18 USPQ 1885, 1888 (CAFC 1991).

For at least the foregoing reasons, the Applicants submit that claims 20 and 40 are not unpatentable under 35 U.S.C. § 103 over Burman in view of Ginzburg, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claims 4, 9, 13, 19, 32, 35, and 41-48 under 35 U.S.C. § 103.

In paragraph 9 of the Office Action, the Examiner rejects claim 41 under 35 U.S.C. § 103 as being unpatentable over Burman in view of U.S. Patent No. 6,512,778 to Jones et al. (hereafter Jones). The Applicant respectfully traverses these rejections for at least the following reasons.

Applicant maintains that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As discussed above, for a valid *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references when combined must teach or suggest all the claim limitations." The initial burden is on the Examiner to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Regarding the Examiner’s rejection of dependent claim 41, for at least the reasons that this claim is directly or indirectly dependent from a respective independent claim whose limitations are not identically taught or suggested, the limitations of this dependent claim, when viewed through or in combination with the limitations of the respective independent claim, are also not identically taught

or suggested. Applicants therefore respectfully request reconsideration and allowance of dependent claim 41 so that this claim may issue in a timely manner.

In addition, the Examiner concedes that “Burman et al fails to teach the step of entering a hint mode” Applicants concur. The Examiner then points to Jones to purportedly remedy these defects. As discussed above in conjunction with the rejections of claims 1 and 21, Burman teaches away from Applicants’ invention. A prior art reference which teaches away from the presently claimed invention is “strong evidence of nonobviousness.” In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 2d 685 (Fed.Cir. 1987). Applicants submit that since Burman teaches away from Applicants’ invention, the combination of Jones and Burman would not result in Applicants’ invention.

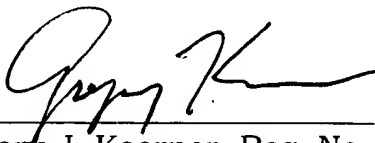
For at least the foregoing reasons, the Applicants submit that claim 41 is not unpatentable under 35 U.S.C. § 103 over Burman in view of Jones, and that the rejections under 35 U.S.C. § 103 are thus improper. The Applicants therefore respectfully request reconsideration and withdrawal of the rejections of claim 41 under 35 U.S.C. § 103.

Summary

Applicants submit that the foregoing amendments and remarks overcome the Examiner's rejections under 35 U.S.C. §102 and 35 U.S.C. §103. Because the cited references, or the Examiner's citations thereto, do not teach or suggest the claimed invention, and in light of the differences between the claimed invention and the cited prior art, Applicants therefore submit that the claimed invention is patentable over the cited art, and respectfully request the Examiner to allow claims 1-43 so that the present Application may issue in a timely manner. If there are any questions concerning this amendment, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,

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